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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,105	04/19/2004	Thomas D. Weldon	0341-0028.07	1449

7590 08/17/2005

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EXAMINER

WILLIAMS, CATHERINE SERKE

ART UNIT PAPER NUMBER

3763

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/827,105	<b>Applicant(s)</b> WELDON ET AL.	
	<b>Examiner</b> Catherine S. Williams	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: on page 3 line 29 patent number 5,147,355 has been written incorrectly as 5,147,305.

Appropriate correction is required.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: on line 12 –the—should be inserted between “contact with” and “open distal end”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-9,11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sorensen (USPN 1,889,425). Sorensen discloses a method that includes the steps of providing a catheter having a proximal end portion and a distal end portion, first (2) and second (3) coaxial passageways extending between the proximal end and the distal end, the first passageway has an open distal end (14) and the first and second passageways are in flow communication with each other proximate the distal end portion (see figure 1); placing the distal end of the first

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passageway over a desired section of tissue (see figure 2); drawing the desired section of the tissue into contact with the open distal end of the first passageway so as to isolate the desired section of tissue by using a suction force (see page 2 column 1 lines 10-12); communicating a tissue treatment fluid into the second passageway through the proximal end for treating the desired section of tissue at the distal end (see page 2 column 1 lines 13-15) where the treatment fluid is directed from the second passageway to the first passageway (see figure 2); and removing the tissue treatment fluid through the first passageway (see page 2 column 1 lines 19-22).

Claims 8-9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Bridgman (USPN 3,804,089). Bridgman discloses a method that includes the steps of providing a catheter having a proximal end portion and a distal end portion, first (40) and second (44) axial passageways extending between the proximal end and the distal end, the first passageway has an open distal end (42) and the first and second passageways are in flow communication with each other proximate the distal end portion; placing the distal end of the first passageway over a desired section of tissue (see figure 2); drawing the desired section of the tissue into contact with the open distal end of the first passageway so as to isolate the desired section of tissue by using a suction force (see 1:41-50); communicating a tissue treatment fluid into the second passageway through the proximal end for treating the desired section of tissue at the distal end (see 2:21-27) where the treatment fluid is directed from the second passageway to the first passageway; and removing the tissue treatment fluid through the first passageway (see 1:49-50).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen.

Sorensen meets the claim limitations as described above but fails to include a syringe for generating the suction force. However, syringes are well known in the art for fluid aspiration and range in application from a blood withdraw device to a wound irrigator/aspirator. At the time of the invention, one skilled in the art would have been knowledgeable of the particular uses of syringes in the art and would have recognized the particular advantages of using a syringe for generating a suction force, i.e. light weight, gentle suction force and ability to maintain a predetermined force. The motivation for substituting a syringe for the suction source of Sorensen by one skilled in the art would have been to provide a light weight gentle suction mechanism that would not require the use of an additional hand (see figure 1 and 2:97-99) for controlling the suction force.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,723,069.

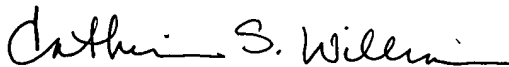
Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 8 and 10 recite providing a catheter having a proximal end portion and a distal end portion (clm1:3-7), first and second coaxial passageways extending between the proximal end and the distal end (clm1:8-15), the first passageway has an open distal end (clm1:11) and the first and second passageways are in flow communication with each other proximate the distal end portion (clm 1:18); placing the distal end of the first passageway over a desired section of tissue(clm 1:24+); drawing the desired section of the tissue into contact with the open distal end of the first passageway so as to isolate the desired section of tissue by using a suction force(clm1:24+); communicating a tissue treatment fluid into the second passageway through the proximal end for treating the desired section of tissue at the distal end where the treatment fluid is directed from the second passageway to the first passageway (clm1:19-23); and removing the tissue treatment fluid through the first passageway (clm1:22-23). The suction force is also provided by a syringe (clm 2:1-3).

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 571-272-4970. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Catherine S. Williams  
August 15, 2005